

### **REMARKS**

Claims 59-63 and 66-69 were pending in the present application before entry of the present amendment. New claim 70 has been added.

Support for new claim 70 can be found, *e.g.*, at page 4, lines 24-27, of the present application as originally filed. No new matter has been introduced.

Upon entry of the present amendment, claims 59-63 and 66-70 are pending.

#### **The Double Patenting Rejection**

Claims 59-62 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting over co-pending U.S. Patent Application No.: 10/466,811 ("811 Application").

Applicants submit herewith a terminal disclaimer. Applicants respectfully request that the double patenting rejection be withdrawn in view of the terminal disclaimer.

A fee of \$140 is believed to be due under C.F.R. 1.20 (d) for the submission of this terminal disclaimer. Please charge this fee, and any other fee that may be required, to Jones Day Deposit Account No. 50-3013.

#### **The Rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph**

Claims 62 and 69 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. In particular, the Examiner alleges that the metes and bounds of "hybridize under stringent conditions" is not clear (page 4 of the office action, dated December 9, 2009). Applicants respectfully disagree as set forth in detail below.

#### **A. The Legal Standard**

"The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.” M.P.E.P. § 2173.02.

“The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent.” M.P.E.P. § 2173.

#### B. The Claim Language is Definite

High stringency conditions were well known to a person skilled in the art at the time the application was filed. For example, Fisher *et al.*, 1984, PNAS, 81:520-524 (reference C243 in the Eighth Supplemental Information Disclosure Statement submitted concurrently herewith) describes DNA hybridization under conditions of high stringency (see page 520, col. 2, last paragraph to page 521, col. 1, first paragraph).

Accordingly, the skilled artisan at the time of the present application was filed, in view of the teachings of the knowledge in the art would have been familiar with the term conditions for hybridization “under stringent conditions” and would have known what conditions are required. In addition, the present application provide guidance for the meaning of the term stringent conditions at page 4, lines 24-27. In particular, according to this section of the present application the percentage of homology of two nucleic acids that hybridize to each other under stringent conditions is 90% or higher. The skilled artisan could thus adjust the hybridization conditions such that only nucleic acids with homologies of 90% or higher would hybridize to each other.

Accordingly, the claim language in view of the common general knowledge in the art and the present specification would have been so clear as to inform the public what the boundaries of the presently claimed invention are.

**CONCLUSION**

The Commissioner is authorized to charge any required fee to Jones Day  
Deposit Account No. 50-3013.

Applicants respectfully request that the above remarks and amendments be  
entered and made of record in the present application file.

Respectfully submitted,

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